

Appl. No. 09/545,336
Amdt. dated December 9, 2003
Reply to Office Action of September 11, 2003

REMARKS:

Status of claims:

Claims 1 and 2 stand rejected. Applicants have added 9 new claims (claims 3-11).

Argument

In his December 19, 2002, Office Action, the Examiner rejected claims 1 and 2 under 35 U.S.C. § 103(a) over Wang (USPN 6,038,333) in view of Hiramatsu (USPN 5,180,901) and further in view of Morinaga (USPN 6,137,685). In a reply dated June 19, 2003, Applicant argued that a modification of the Wang device to meet the limitations of Applicant's invention would destroy the intended function taught by Wang.

In his September 19, 2003, Office Action, the Examiner stated that the arguments made with respect to claims 1 and 2 were persuasive, and withdrew the rejections. But the Examiner nevertheless rejected claims 1 and 2 over the Wang and Morinaga references again, this time citing Morinaga as a primary reference.

Applicants respectfully traverse the rejections of claims 1 and 2.

First, Morinaga does not disclose a "human user identification and verification system." Morinaga is not at all concerned with facial recognition.

Morinaga describes what is analogous to a PCI slot for a "portable electronic information device" like a portable computer or personal digital assistant. Morinaga says that the prior art includes "a card-shaped information medium 4 called an IC (integrated circuit) card having a memory function or the like." Col. 1, lines 19-21. The computer then uses "the memory or the like of the card-shaped information medium 4" to perform information processing. Col. 1, lines 19-27. According to Morinaga, a problem with the prior art was that the device body (e.g., the tablet computer, PDA, etc.) for receiving the card – not the card itself – was too bulky. Col. 1, lines 30-45.

Therefore, Morinaga proposes a space-saving physical interface on the card-reading device for receiving the card. *Compare* FIGS. 2 and 3. Most of Morinaga's disclosure is concerned with the physical interconnection between the slot and the card. Morinaga, on the other hand, is extremely general about the functionality of the card. Basically, Morinaga suggests that the card could embody anything – a memory card, a modem card, or a camera card.

Given the objects of the Morinaga invention, a person of ordinary skill in the art would not expect to find much description of the functionality of the card itself. Indeed, Morinaga has only 2 sentences describing an electronic camera, namely:

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Further, as shown in FIG. 1, an electronic camera 28 may be provided at the card-shaped information medium 4. In such an arrangement, an image can be photographed by using the electronic camera 28, and an address table with face pictures can be prepared easily by combining the photographed images and an address table.

Morinaga does not state or suggest that any images be stored on the card itself. Furthermore, Morinaga suggests only a single function be performed with the images – that they be combined with an address table. Morinaga does not suggest that the images be used with an image recognition system, as claimed in claims 1 and 2.

The Examiner correctly recognized that Morinaga does not disclose using the portable electronic information device as a non-invasive human user identification and verifications system. But the Examiner assumes that a person of ordinary skill in the art would be motivated to modify Morinaga in view of Wang to add that capability.

“When an obviousness determination is based on multiple prior art references, there must be a showing of some ‘teaching, suggestion, or reason’ to combine the references.” *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). Indeed, “a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential evidentiary component of an obviousness holding.’” *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000). Moreover, “[t]his showing must be clear and particular” *Id.*

Significantly, “[t]he absence of such a suggestion to combine is dispositive in an obviousness determination.” *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-79 (Fed. Cir. 1997) (emphasis added). The Federal Circuit has repeatedly demanded a “rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references” as an antidote to “the subtle but powerful attraction of a hindsight-based obviousness analysis.” *In re Dembicza*, 175 F.3d 994, 999 (Fed. Cir. 1999). “Actual evidence” of a suggestion, teaching, or motivation to combine is required. *Id.*

Applicants disagree that it would be obvious to combine Morinaga with Wang “to provide a personal identifier and management system that is portable, personal, and easy to use to assist a user in recognizing or recalling people the user has previously met, retrieve personal-identifying information from a database in accordance with an input face image, or searching a face image database for similar faces in order to identify the input face.” (OA, at 3, 4). That argument assumes that Wang is not already “portable, personal, and easy to use to assist a user in recognizing or recalling people the user has previously met” It is not at all apparent why combining Morinaga with Wang would make Wang any more portable, personal, and image-recognition-functional than it already was. Absent some improvement over the prior art, there would be no motivation to make the combination or modification.